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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,981	04/05/2004	Larry Dupuis	81094071 / FMC 1692 PUS	2980
28395	7590	06/13/2006	EXAMINER	
BROOKS KUSHMAN P.C./FGTL 1000 TOWN CENTER 22ND FLOOR SOUTHFIELD, MI 48075-1238			BOTTORFF, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/708,981	Applicant(s) DUPUIS ET AL.	
	Examiner Christopher Bottorff	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed March 31, 2006 has been entered. Claims 1-10 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The meaning and scope of the term "secure" is not clear in the claims. The use of "secured" in the specification suggests that an object "secured" to another object involves a direct connection between the two objects. For example, paragraph 0018 states that "[a] plurality of bolts 98 extend through a plurality of clearance holes 100 located in the battery tray 68 and secure the battery tray firmly to the battery support portions 34 and 52." Figures 2 and 3 depict this secured relationship such that the bolts directly connect vertical sides walls of the battery tray to side walls of the two tubular frame members.

In contrast, Claim 1, as amended, requires the accessory tray to be "secured" to a *top* surface of the base support portion, which suggests that the claim term "secured" only requires an indirect connection between components such that a direct connection with a side wall will "secure" the tray to a top surface. Thus, the claims are not clear as

to whether or not “secured” requires a direct connection between components or may broadly involve an indirect connection via intermediate components.

For the purposes of examination, the term “secured” in the claims has been interpreted to require at least an indirect connection via intermediate components. In the event that “secured” is intended to define a direct connection, the direct connection between the accessory tray and the top surface of the base support portion, as defined in claim 1, is not disclosed in accordance with 35 USC 112, first paragraph, and is not depicted in the Figures.

In addition, claim 5 recites the limitation “the battery tray is secured to the transversely extending portion” in lines 14-15. However, two distinct transversely extending portions are defined in the claim. The first transversely extending portion is recited on line 5 in relation to the first tubular member. The second transversely extending portion is recited on line 10 in relation to the second tubular member. Consequently, the claim is not clear as to which of the transversely extending portions the battery tray is secured. For the purposes of examination, claim 5 has been interpreted as requiring the battery support tray to be secured to the transversely extending portion of the second tubular member.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu US 6,699,616.

Wu discloses a vehicle battery support structure 10, 220 comprising: a first tubular frame member formed of the portion of assembly 220 that connects to front part 210 and accommodates the post of seat 250; a second tubular frame member formed of the portion of assembly 220 that extends laterally beneath the first tubular frame member and rearward beneath the rear wheel axle; and a battery tray 10. See Figures 2 and 3. The first tubular frame member has a transversely extending portion 221 and a longitudinally extending portion that connects to front part 210 and accommodates bolts 230 and 240. See Figure 2. The second tubular frame member is disposed at least in part adjacent to the first tubular frame member, has a transversely extending base support portion disposed beneath the flat plate of assembly 220 and spaced rearwardly from the transversely extending portion 221 of the first tubular frame member, and is secured to the first tubular frame member. See Figure 3.

Since the battery tray 10 is secured to assembly 220, the battery tray is at least indirectly connected to both the transversely extending portion and the longitudinally extending portion of the first tubular frame member, including a side wall of the first tubular frame member, and to a top surface of the base support portion of the second tubular frame member. See Figure 1. Also, the battery support structure 10, 220 is

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capable of storing accessories, such as a battery and wiring, in an engine compartment formed by the space that accommodates engine 290 and its power supply 20.

The battery tray 10 includes a battery supporting surface on a base portion adjacent contact 15, and the base portion is also secured to the base support portion since the battery tray 10 is secured to the assembly 220. See Figures 3 and 5. The battery supporting surface is supported by the base support portion via the flat plate of assembly 220. See Figures 3 and 5. Furthermore, the battery tray 10 has an upstanding front wall and an upstanding transverse side wall adjacent to the first tubular frame member, and these walls are secured to side wall supports formed by the structure of the first and second tubular members. See Figure 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu US 6,699,616 in view of Beckman US 6,769,178.

Wu does not disclose that the tubular frame members are manufactured through the hydroforming process. However, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend upon its method of

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production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Here, the claimed tubular frame members are the same as the tubular frame members of Wu, and claim is unpatentable even though the tubular members of Wu were not necessarily formed by the hydroforming process.

Moreover, Beckman teaches the desirability of forming tubular frame members by hydroforming. See column 2, lines 39-44 and 45-59. From the teachings of Beckman, forming the tubular members of Wu by hydroforming would have been obvious to one of ordinary skill in the art at the time the invention was made. This would effectively form the frame members into the desired box shape.

Allowable Subject Matter

Claim 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. Claim 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. Claims 6-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art does not suggest, in combination with the further limitations of claim 5, securing the battery tray to the transversely extending portion of the second tubular member by one upstanding side wall and also securing the battery tray to the

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longitudinally extending portion of the first tubular member by another upstanding side wall, as defined in claim 5. In Wu, the battery is not secured by the sidewalls. The prior art also does not suggest, in combination with the further limitations of claim 10, arranging a battery tray to overly and be secured to front end tubular frame members.

In addition, the previous indication of allowability of claim 9 is hereby withdrawn due to the lack of clarity in the meaning of "secured" introduced by the amendment to claim 1. Claim 9 is rejected as described above in accordance with the interpretation of "secured" applied throughout the claims.

Response to Arguments

Applicant's arguments filed March 31, 2006 have been fully considered but they are not persuasive.

In regard to claim 1, Applicants assert that Wu only teach the storage of vehicle batteries and not accessories in an engine compartment. However, the limitation at issue is merely the preamble statement of intended use. However, it is well settled that claims containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all of the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Wu teaches all of the structural limitations of the claim and the claimed intended use does not differentiate the claimed apparatus from the apparatus of Wu. Furthermore, the batteries and electrical

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wiring of Wu are accessories that support an engine 290, and the engine and accessories are stored in a compartment beneath cover 10'.

Also, as noted in the above rejection under 35 USC 112, second paragraph, the term "secured" has been interpreted to require at least an indirect connection via intermediate components. The tray 10 of Wu is indirectly connected to all of the members of scooter 200, including the tubular members of the frame, when the tray 10 is positioned on assembly 220 via numerous intermediate components. In this broad sense, tray 10 is "secured" to the surfaces and side walls of both the first and second tubular members.

In regard to claim 9, the amendment to provide proper antecedent basis is noted. The deficiency in antecedent basis was overlooked during earlier examination and should have been rejected under 35 USC 112, second paragraph. Nonetheless, the amendment overcomes the grounds of rejection for lack of antecedent basis.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

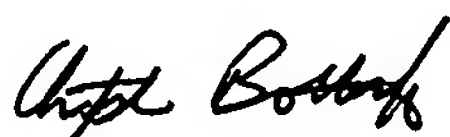
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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